IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Timothy S. DeBruine et al. Examiner: Kamal B. Divecha
Serial No. 09/814,426 Art Unit: 2151
Filed: 03/21/2001
For: **METHOD AND SYSTEM FOR OPTIMIZING PRIVATE NETWORK FILE TRANSFERS IN A PUBLIC PEER-TO-PEER NETWORK**

Mail Stop Appeal Brief – Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

A **REPLY BRIEF** is filed herewith in response to the Examiner's Answer mailed September 24, 2008. If any fees are required in association with this Reply Brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

REPLY BRIEF

A. Introduction

In response to the Examiner's Answer mailed September 24, 2008 (hereinafter "Examiner's Answer"), the Appellants submit that claims 1-47 are patentable over the references cited in the Final Office Action mailed April 4, 2008 (hereinafter "Final Office Action"). In particular, none of the cited references, either alone or in combination, disclose the feature of a server, which determines that first and second nodes, which are part of a peer-to-peer network, are also part of the same private network.

B. Rejections

In the Final Office Action, claims 1-7, 9, 13-19, 21, 25-31, 33, and 37-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0062336 A1 to *Teodosiu et al.* (hereinafter "*Teodosiu* '336") in view of U.S. Patent No. 6,393,488 B1 to *Araujo* (hereinafter "*Araujo*"). In the Final Office Action, the Patent Office also rejected claims 8, 10, 12, 20, 22, 24, 32, 34, 36, 41, and 43-47 under 35 U.S.C. § 103(a) as being unpatentable over *Teodosiu* '336 in view of *Araujo* and further in view of U.S. Patent No. 6,636,854 B2 to *Dutta et al.* (hereinafter "*Dutta*"). The Patent Office also rejected claims 11, 23, 35, and 42 under 35 U.S.C. § 103(a) as being unpatentable over *Teodosiu* '336 in view of *Araujo* and *Dutta* and further in view of U.S. Patent No. 6,553,310 B1 to *Lopke* (hereinafter "*Lopke*"). Claims 1, 7, 8, 13, 19, 20, 25, 31, and 44-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of U.S. Patent Application Publication No. 2002/0066026 A1 to *Yau et al.* (hereinafter "*Yau*") in the Final Office Action. Claims 2, 6, 14, 26, 30, and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Yau* and further in view of U.S. Patent No. 6,304,912 B1 to *Oguchi et al.* (hereinafter "*Oguchi*") in the Final Office Action. Claims 3-5, 9, 10, 12, 15-18, 21, 22, 24, 27-29, and 33-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Yau* and *Oguchi* and further in view of *Araujo* in the Final Office Action. Claims 11, 23, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Yau*, *Oguchi*, and *Araujo*, and further in view of *Lopke* in the Final Office Action. Claims 37 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Yau* and further in view of *Araujo* in the Final Office Action. Claims 38-41 were rejected under 35 U.S.C. § 103(a) as

being unpatentable over *Dutta* in view of *Yau* and *Araujo* and further in view of *Oguchi* in the Final Office Action. Finally, claims 42 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Yau*, *Araujo*, and *Oguchi* and further in view of *Lopke* in the Final Office Action.

C. Arguments

Claims 1-7, 9, 13-19, 21, 25-31, 33, and 37-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Teodosiu* '336 in view of *Araujo*. The Appellants respectfully traverse the rejection. Initially, the Appellants wish to point out that *Teodosiu* '336 is not prior art against that present application. Specifically, *Teodosiu* '336 was filed on September 13, 2001, the present application has a filing date of March 21, 2001, well before the filing date of *Teodosiu*. Nonetheless, *Teodosiu* claims priority to Provisional Application No. 60/252,658 filed on November 22, 2000 (hereinafter "*Teodosiu* '658") and Provisional Application No. 60/252,659, also filed on November 22, 2000 (hereinafter "*Teodosiu* '659"). Therefore, only the subject matter disclosed in *Teodosiu* '658 and *Teodosiu* '659 is available as prior art against the present application.

According to Chapter 2143.03 of the M.P.E.P., in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught by the prior art. The Appellants submit that none of the references, either alone or in combination, disclose or suggest all the features recited in claims 1-7, 9, 13-19, 21, 25-31, 33, and 37-40. More specifically, claim 1 recites a method for optimizing private network file transfers comprising, among other features, "determining by the server that the first and second nodes are part of the same private network," where the first and second nodes are part of a peer-to-peer network. Claims 13, 25, and 37 include similar features. The Appellants submit that none of the references, either alone or in combination, disclose or suggest determining by a server that first and second nodes, which are part of a peer-to-peer network, are also part of a same private network. In maintaining the rejection, the Patent Office refers to paragraphs **[0044]-[0047]** and **[0124]** of *Teodosiu* '336.[1] Specifically, the Patent Office indicates that *Teodosiu* '336 discloses a "peer to peer network comprising two or more peers, which are part of the peer to peer network and part of the private

[1] *See* Examiner's Answer, pages 19 and 20.

LAN, i.e., same private network."[2] The Appellants submit that the subject matter relied upon in the Examiner's Answer is not prior art against the Appellants' invention. Specifically, the Appellants have reviewed *Teodosiu* '658 and *Teodosiu* '659 and submit that these references do not disclose the subject relied upon by the Patent Office. At most, *Teodosiu* '658 discloses that user space may be partitioned into clusters of user machines that are served by one RNS server.[3] However, no mention is made, or suggested, regarding peers, which are part of a peer to peer network and part of the same private network.

The Patent Office also states that "*Teodosiu* discloses sending locations of the resource that are closest and/or proximal in terms of network topology to the requesting peer in order to optimize network traffic."[4] The Appellants submit that the subject matter relied upon in the Examiner's Answer is not prior art against the Appellants' invention. In particular, the Appellants have reviewed *Teodosiu* '658 and *Teodosiu* '659 and submit that these references do not disclose the subject matter relied upon by the Patent Office. At most, *Teodosiu* '658 discloses that, when a request is received, a RNS server locates a file and then returns a list of locations that can serve the requested content.[5] Furthermore, *Teodosiu* '658 discloses that a peer selects one or more locations from the list and then directly contacts these locations.[6] However, *Teodosiu* '658 does not disclose, or suggest, sending locations that are closest to and/or proximal to, in terms of network topology, a requesting peer, in order to optimize network traffic.

Similarly, *Araujo* does not disclose this feature. At most, *Araujo* discloses determining if a device resolving a DNS is included in the same LAN as a device initiating a URL request. (See *Araujo*, Figure 5, element 511; and col. 7, ll. 31-33). However, the Appellants submit that *Araujo* does not disclose that the devices in the same LAN are part of a peer-to-peer network.

In addition, the Patent Office responds to the argument that none of the references disclose determining by a server that first and second nodes, which are part of a peer-to-peer network, are also part of a same private network by indicating that the Appellants are attempting to show non-obviousness by arguing the references individually. (See Final Office Action mailed April 4, 2008, page 3 and Examiner's Answer, page 25). The Appellants respectfully disagree. Particularly, the Patent Office has acknowledged that *Teodosiu* does not disclose that a

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[2] *See* Examiner's Answer, page 24.
[3] *See Teodosiu* '658, page 4, ll. 12-13.
[4] *See* Examiner's Answer, page 24.
[5] *See Teodosiu* '658, page 6, ll. 11-19.
[6] *See Teodosiu* '658, page 6, ll. 20-21.

server determines that first and second nodes are part of the same private network. (See Office Action mailed November 1, 2007, page 7; and Final Office Action mailed April 4, 2008, page 7). Thus, the Patent Office has implicitly acknowledged that *Teodosiu* does not disclose that a server determines that first and second nodes are part of the same private network, where the first and second nodes, which are part of the same private network, are also part of a peer-to-peer network. In light of the acknowledged shortcoming in *Teodosiu*, the Patent Office turns to *Araujo*. The Appellants are merely rebutting the argument proffered by the Patent Office explaining why, just like *Teodosiu*, *Araujo* does not disclose determining by a server that first and second nodes, which are part of a peer-to-peer network, are also part of a same private network. Thus, the Appellants, are arguing why, in combination, neither *Teodosiu* nor *Araujo* discloses or suggests all of the features recited in claims 1-7, 9, 13-19, 21, 25-31, 33, and 37-40.

The Patent Office responds to this line of reasoning by stating that the "Examiner clearly indicated that Teodosiu does not disclose the process of determining by a server that the first node and second node are part of the same private network."[7] The Patent Office goes on to state that this does not mean that "'Teodosiu does not disclose that a server determines that first and second nodes are part of the same private network, where the first and second nodes, which are part of the same private network, are also part of a peer-to-peer network.'"[8] The Appellants submit that if *Teodosiu* does not disclose the process of determining by a server that the first node and second node are part of the same private network, as admitted by the Patent Office, then it naturally follows that *Teodosiu* cannot disclose a server which accomplishes both the function of determining that the first node and second node are part of the same private network and determining that the nodes are part of a private network. Accordingly, claims 1, 13, 25, and 37 are patentable over *Teodosiu* and *Araujo*. Likewise, claims 2-7, 9, 14-19, 21, 26-31, 33, and 38-40, which variously depend from claims 1, 13, 25, or 37, are patentable for at least the same reasons along with the novel features recited therein.

Regarding the remaining rejections, the Appellants submit that the pending claims are patentable over *Dutta*, *Lopke*, *Yau*, and *Oguchi* for the reasons set forth in the Appeal Brief filed on August 28, 2008.

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[7] *See* Examiner's Answer, page 26.
[8] *See* Examiner's Answer, page 26.

D. Conclusion

As detailed above, none of the references, either alone or in combination, disclose or suggest a server that determines that first and second nodes, which are part of a peer-to-peer network, are also part of the same private network. As such, the Appellants request that the Board reverse the Examiner and instruct the Examiner to allow the claims.

Respectfully submitted,

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